

REMARKS

In the Office Action, claims 1 - 25 were noted as pending in the application, and all claims were rejected. By this amendment, claims 1 - 3, 5 - 6, 9, 17, 20 - 22, and 25 have been amended; and no claims have been canceled or added. Thus, claims 1 - 25 are pending in the application. The rejections of the Office Action are traversed below.

Priority of the Application

In item 2, on page 2 of the Office Action, it is asserted that Applicants have failed to comply with all requirements for claiming priority under 35 U.S.C. §119 to an earlier-filed foreign application. Applicants have amended the first paragraph of the specification to correct the omission of the serial number of a Patent Cooperation Treaty international application, namely Application No. PCT/US00/032746. Acknowledgement that all the conditions for receiving the benefit of an earlier filing date under 35 USC §119 have been complied with is respectfully requested.

Objection to the Specification

In item 3, on page 2 of the Office Action, the abstract of the disclosure is objected to as exceeding 150 words in length. The Applicants have amended the specification herein to replace the abstract with a paragraph that is less than 150 words in length. Withdrawal of the objection to the abstract is respectfully requested.

Rejection of Claims 1 - 25 under 35 USC §112

In item 6, on pages 3 - 4 of the Office Action, claims 1 - 3, 5 - 6, 9, 17, 20 - 22, and 25 were rejected under 35 USC §112, second paragraph as being indefinite. In particular, the Office Action asserted that the term, “e-original,” is used in the claims as a trademark or trade name. The Applicants respectfully disagree. As recited in the claims and as disclosed in the specification, the term, “e-original,” is an abbreviation for the term, “electronic original.” See specification at page 4, lines 13 - 20; page 5, lines 29 - 32; page 17, lines 16 - 22. However, in the interests of furthering prosecution and clarifying the claims, all occurrences of “e-original” in the claims have been amended herein to recite “electronic original.”

Withdrawal of the rejection of claims 1 - 3, 5 - 6, 9, 17, 20 - 22, and 25 under 35 USC §112, second paragraph is respectfully requested.

In item 6, on page 4 of the Office Action, claims 1 - 3, 5 - 6, 9 - 10, 13 - 20, 22 - 23, and 25 were rejected under 35 USC §112, second paragraph as being indefinite. In particular, the Office Action asserted that the term, “trusted custodial utility (TCU),” is used in the claims as a trademark or trade name. The Applicants respectfully disagree. As recited in the claims and as disclosed in the specification, the term, “TCU,” is an abbreviation for the term, “trusted custodial utility” and does not, to Applicants’ knowledge, represent a trademark or trade name. As correctly noted by the Office Action, a TCU is a trusted third-party repository of information objects. See specification at page 4, lines 17 - 20. Withdrawal of the rejection of claims 1 - 3, 5 - 6, 9 - 10, 13 - 20, 22 - 23, and 25 under 35 USC §112, second paragraph is respectfully requested.

In item 7, on page 5 of the Office Action, claim 7 is rejected under 35 USC §112, second paragraph as lacking antecedent basis. Claim 7 has been amended herein to remedy the lack of antecedent basis, and withdrawal of the rejection of claim 7 under 35 USC §112 is respectfully requested.

Rejection of Claims 1 - 21 and 25 under 35 USC §101

In item 8, on pages 5 - 6 of the Office Action, claims 1 - 21 and 25 were rejected under 35 USC §101 as being directed to non-statutory subject matter. Independent claims 1, from which claims 2 - 21 depend, and claim 25 have been amended herein to recite “A computer implemented method of handling stored electronic original objects” Support for the amendment can be found in the specification at least at page 12, lines 25 - 27; page 13, lines 1 - 12; page 37, lines 9 - 11; and page 45, lines 29 - 31. The Applicants respectfully submit that the application, as both disclosing and reciting the methodology as performed on a computer, is within the technological arts as required by the rules of the U.S. Patent and Trademark Office, including the requirements specified in *In re Bowman*, 61 USPQ2d 1669, 1671 (Bd of Pat Appeals and Intf 2001). Withdrawal of the rejection is respectfully requested.

Rejection of Claims 1 - 2 under 35 USC §103

In item 10, on pages 6 - 8 of the Office Action, claims 1 - 2 were rejected under 35 USC § 103 as being unpatentable over U.S. Patent 5,191,613 to Graziano et al. in view of U.S. Patent No. 4,885,777 to Takaragi et al. This rejection is respectfully traversed.

The Graziano et al. Patent

Graziano et al. discloses a system and method for document authentication (Graziano et al. at abstract; Col. 2, lines 7 - 9). Parties desiring to negotiate a document such as a contract work independently or together in real time to develop the desired document (Col. 10, line 44 - Col. 11, line 47). During document development, the document can be checked for modification (Col. 7, lines 10 - 15; Col. 12, lines 48 - 53). Upon completion of the document, it is digitally signed and copies are transferred to the parties (Col. 7, lines 25 - 35; Col. 14, lines 9 - 17). The document authentication software can reside on each party's respective computer or with an unrelated third party (Col. 10, line 44 - Col. 11, line 47; Col. 14, lines 31 - 43; Fig. 1).

The Takaragi et al. Patent

Takaragi et al. discloses a system and method for electronically sending and receiving digital signatures between transacting parties (Takaragi et al. at abstract; Col. 4, lines 34 - 43). A sender/signer prepares, digitally signs, and sends an electronic message to a receiver/certifier (Col. 5, lines 13 - 18). The message is encrypted by use of a secret key and is subsequently decoded by use of a public key (Col. 6, lines 37 - 41; Col. 9, lines 23 - 27).

The Claimed Invention is Patentably Distinguishable Over the Cited Documents

The Applicants' claimed invention is directed to a method of handling stored electronic original objects. In particular, and reciting the features of claim 1, there is claimed a computer implemented method of handling stored electronic original objects that have been created by signing information objects by respective transfer agents, submitting signed information objects to a trusted custodial utility (TCU), validating the submitted signed information objects by at least testing the integrity of the contents of each signed information object and the validity of the signature of the respective transfer agent, and applying to each validated information object a date-time stamp and a digital signature and authentication

certificate of the TCU, which handles at least one electronic original object based on rules established by an owner of the at least one electronic original object, including the steps of:

- establishing at least one type of electronic original object;
- establishing at least one type of electronic original object as potential transferable records;
- enabling at least one selected user to access at least one selected type of electronic original object;
- identifying at least one type of electronic original object required to conclude a deal;

and

- controlling transformation of a selected electronic original object into a transferable record.

Embodiments recited within the features of claim 1 are directed to a method of handling stored electronic original objects, including controlling transformation of a selected electronic original object into a record for transferring ownership of the object (see specification at page 34, lines 22 - 24; page 40, lines 4 - 9). The Office Action cites to the Graziano et al. as allegedly disclosing most of the features recited in claim 1. The Applicants respectfully disagree. As regards the transformation of an object into a transferable record, the Office Action cites to Graziano et al. at Col. 5, line 66 - Col. 6, line 23 as allegedly disclosing this feature. However, the cited portion of Graziano et al. merely discusses the electronic equivalents of storing, signing, and transmitting paper documents. Graziano et al. is completely silent regarding the transferring of ownership of an electronic original object, but less the recited feature of controlling transformation of a selected object into a transferable record.

The Office Action admits that the Graziano et al. document fails to disclose applying to each validated information object, a date-time stamp, and a digital signature and authentication certificate. The Office Action introduces the Takaragi et al. document as allegedly disclosing these features. However, the Applicants respectfully assert that the Office Action's reliance on Takaragi et al. is misplaced. The date-time stamp as recited in claim 1 is applied to the electronic object as a current time indicator (see specification at page 41, lines 29 - 33). In contrast, the date applied to the electronic seal in the Takaragi et al.

document comprises a grace period indicating a future time deadline by which a party can terminate a transaction.

For at least the reasons discussed above, claim 1 is believed to be patentably distinguishable over Graziano et al. and Takaragi et al., either taken alone or in combination. Accordingly, it is respectfully requested that the rejection of claim 1 be withdrawn.

Claims 2 - 21 depend from claim 1 and include all the features of that claim plus additional features. Therefore, for at least the reasons set forth above with respect to claim 1, it is submitted that claims 2 - 21 patentably distinguish over the Graziano et al. and Takaragi et al. documents, and withdrawal of the rejection of claims 2 - 21 is respectfully requested.

While teachings of several documents may be combined to render a claimed invention obvious, there must be a motivation or suggestion in the documents relied upon to make the specific combination. The Applicants respectfully assert that no suggestion or motivation exists in either Graziano et al. or Takaragi et al. to combine these document in the manner suggested by the Office Action. The Office Action asserts on page 8 that it would have been obvious to make such a combination to allow a user more time to determine if any of the authentication materials are invalid. However, the Graziano et al. system is directed to a computer implemented system for automatically ensuring the authenticity of electronic documents (see Graziano et al. at Col. 2, lines 7 - 14; Col. 4, lines 38 - 46). Accordingly, there would be no need to modify the self-authenticating system with the grace period feature of Takaragi et al. in the manner suggested by the Office Action. For this additional reasons, it is respectfully asserted that claims 1 - 25 are patentable distinguishable over the Graziano et al. and Takaragi et al. documents, and withdrawal of the rejection of claims 1 - 2 under 35 USC §103 is requested.

Information Disclosure Statements

Applicants wish to draw the Examiner's attention to three Information Disclosure Statements that have been filed in the present application. Said IDS's were filed on March 25, 2003; April 7, 2003; and July 10, 2003. The Applicants respectfully request that these IDS's and the listed documents be considered by the Examiner and that an initialed copy of each of the IDS's be returned to the undersigned.

Substitute Declaration

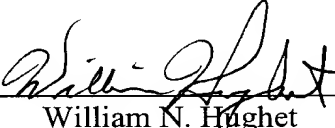
A declaration and power of attorney was filed with this application on December 14, 2000. Upon review of the file for the application, it was discovered that the declaration had not been dated by the signing inventors. Accordingly, a substitute declaration is being filed herein to replace the original declaration, wherein all inventors have signed and dated the substitute declaration.

Summary

It is submitted that none of the documents, either taken alone or in combination, teach the claimed invention. Thus, claims 1 - 25 are deemed to be in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited. If any fees are required in connection with this Amendment, please charge the same to our Deposit Account No. 02-4800.

Respectfully submitted,

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